

REMARKS

The present application was filed on September 18, 2000 with claims 1 through 9. Claim 5 was previously canceled in an Office Action Response dated December 18, 2003. Through a telephone restriction requirement, Applicants selected 5 claims 1, 3, 4, and 8, with traverse. Consequently, claims 1, 3, 4, and 8 are the remaining claims. In the present response, Applicants propose to amend the independent claims 1, 3 and 8. The amendments are supported, *inter alia*, by FIGS. 9 and 15 and related text. In the outstanding final Office Action, the Examiner required restriction of claims and rejected claims 1, 3, 4 and 8 under 35 USC §102(e).

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Restriction Requirement

In the outstanding Office Action, the Examiner required restriction of the application to one of the following two groups of claims: Group I, including claims 1, 3, 4, and 8; and Group II, including claims 2, 6, 7, and 9. The Examiner has withdrawn 15 claims 2, 6, 7, and 9, corresponding to Group II, from consideration.

However, Applicants respectfully assert that the restriction requirement is improper and should be withdrawn. First, since each Group is generally related to techniques for communicating using wireless devices. Second, according to the restriction requirement given by the Examiner (see page 2, §1 of the final Office Action), 20 a complete search for both Groups would require a search of two subclasses in a single class. Accordingly, Applicants submit that an examination of Groups I and II would not impose a serious burden on the Examiner. Furthermore, for the previous two Office Actions prior to the final Office Action, the Examiner performed searches for all claims, and therefore the burden for including both Groups I and II could not be too serious. 25 Where, as here, “[i]f the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.” MPEP §803.

Accordingly, it is respectfully requested that the restriction requirement be reconsidered and withdrawn and that all of the pending claims in the application be 30 examined together in this application. Alternatively, Applicants respectfully select Group I, claims 1, 3, 4, and 8 for prosecution on the merits.

Independent Claims (Claims 1, 3 and 8)

Applicants have made clarifying amendments to independent claims 1, 3, and 8. In particular, Applicants have clarified that the requests for bridging to a call in progress (independent claims 1 and 8) or to join a call in progress (independent claim 3) are performed by the wireless device requesting the action. The amendments are supported, *inter alia*, by FIGS. 9 and 15 and related text, and no new matter has been added.

Furthermore, Applicants respectfully submit that the amendments to the claims should be entered, as the changes are minor and implicit in the original claims 1, 3, and 8. In particular, in independent claim 3, a wireless device initiates a connection with a network node device, communicates a request to join a call in progress, and then joins the call in progress. In this claim, it was implied that the wireless device communicates a request for the *wireless device* to join a call in progress, as the wireless device initiates a connection, communicates the request, then joins the call in progress. Therefore, the added limitations in independent claims 1, 3, and 8 merely recite what was implicit in independent claim 3 and the amendment should be entered.

In the final Office Action, the Examiner rejected all claims under 35 U.S.C. §102(e) as being anticipated by Bradshaw, U.S. Patent No. 6,608,820 (hereinafter, "Bradshaw"). In the final Office Action, the Examiner basically asserts that Bradshaw discloses all limitations of the independent claims.

Applicants respectfully submit that amended independent claims 1, 3, and 8 are patentable over Bradshaw. Amended independent claims 1 and 8 contain the limitation of requesting bridging by the wireless device to a call in progress, while amended independent claim 3 contains a limitation of communicating a request for the wireless device to join a call in progress. In all three amended independent claims, it is the wireless device itself that seeks to join the call in progress and that requests bridging to a call in progress or to join a call in progress.

By contrast, Applicants read Bradshaw as disclosing that a controlling party (i.e., a controlling "mobile station") sends a telephone number of another mobile station to a "base station" when certain conference calling features are desired. See, for instance, col. 2., lines 55-58 of Bradshaw: "In general, a controlling party adds subject

parties to a conference call by entering the digits of each subject party and depressing the Send key."

Nowhere in Bradshaw is it disclosed or implied that the controlling party requests to bridge to or join a call in progress. In other words, the controlling party is the 5 party that sets up an initial call between two parties then adds one or more parties to the existing call. Any requests to "bridge to a call in progress" or "to join a call in progress," if such requests exist in Bradshaw, are from the controlling party to add another party to a call in progress.

Bradshaw does state the following at col. 6, lines 35-53:

10 Continuing to refer to transitions from state 302 [of FIG. 3 of Bradshaw], depression 346 of "Send" causes the network to transition to state 348 wherein the controlling party [Cg Pty] effectively is placed on hold so that CP1 and CP2 may have a private conversation. Although not illustrated, Cg Pty may choose to add another subject, if desired.

15 There are five transitions to other states from state 348. Depression 350 of "Send" causes the network to transition to state 302 wherein Cg Pty, CP1 and CP2 have a conference call. Depression 352 of "1" and "Send" causes the network to transition to state 306 wherein CP2 is placed on hold and Cg Pty and CP1 are placed into a conversation. Depression 354 of "2" and "Send" causes the network to transition to state 20 332 wherein CP1 is placed on hold and Cg Pty and CP2 are placed into a conversation. Depression 356 of "1", "#" and "Send" causes the network to transition to state 312 wherein CP1 is dropped from the call. Depression 358 of "2" and "#" and "Send" causes the network to transition to state 25 332 wherein CP2 is dropped from the call.

The cited text describes certain transitions of states, where different parties can be placed on hold by the controlling party. Although the cited text states that the controlling party can be placed on hold, when the controlling party is on hold, there is still a three way conference call in progress. For instance, Bradshaw also states at col. 5, lines 40-44, 30 "FIG. 3 is a state diagram illustrating state transition logic for a three way conference call according to the preferred embodiment of the invention. Referring now to FIG. 3, it may be seen that the diagram assumes that the three way conference call is already established." Thus, FIG. 3 in Bradshaw is a diagram of an already established three way conference call, and the controlling party in Bradshaw therefore never requests to bridge 35 to or join a call in progress. The text regarding FIG. 4 of Bradshaw also states that the

state diagram of FIG. 4 is of an established three way conference call. See col. 6, lines 59-63 of Bradshaw.

The independent claims of the present invention require a wireless device that requests for the wireless device to bridge to or join a call in progress, and in
5 Bradshaw, the controlling party requests for *another* device to join a conference call set up by the controlling party.

Additionally, Bradshaw never discloses or implies that the identification of the wireless device is communicated by the wireless device along with a request for bridging or a request to join the call in progress, as also claimed in amended independent
10 claims 1, 3, and 8.

Consequently, Applicants respectfully submit that amended independent claims 1, 3, and 8 are patentable over Bradshaw and request that the §102(e) rejection be withdrawn.

15 Dependent Claim 4

Dependent claim 4 is dependent on independent claim 3 and is therefore patentably distinguished over Bradshaw because of its dependency from independent claim 3 for the reasons set forth above, as well as other elements this claim adds in combination to its base claim.

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Conclusion

All of the pending claims, i.e., claims 1, 3, 4, and 8, are in condition for allowance and such favorable action is earnestly solicited.

If any outstanding issues remain, or if the Examiner has any further
25 suggestions for expediting allowance of this application, the Examiner is invited to contact the undersigned at the telephone number indicated below.

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The Examiner's attention to this matter is appreciated.

Respectfully submitted,



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